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| 10/030,844 | 05/07/2002 | Robert Benjamin Franks | 5897-000009 | 4210 |

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| EXAMINER |
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MEYERS, MATTHEW S

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| ART UNIT | PAPER NUMBER |
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3689

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05/15/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/030,844

Applicant(s)

FRANKS ET AL.

Examiner

MATTHEW S. MEYERS

Art Unit

3689

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 33-62 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 33-62 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/CDC)
- 4) ☐ Interview Summary (PTO-413)
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____
- Paper No(s)/Mail Date _____

DETAILED ACTION

1. This action is in response to applicant's communication on 2/5/08, wherein claims 1-32 have been cancelled and claims 60-62 have been added. Therefore, claims 33-62 are currently pending.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 33-62 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kanebo LTD, Application number: 06-030911, Publication number: 07-219935, Published on 18.08.1995 (Hereinafter referred to as Kanebo) in view of Trademark/Service Mark Application, Principal Register, with Declaration, eTEAS - Version 1.2a: 08/22/2000 (Hereinafter referred to as eTEAS).

2. With respect to **Claims 33, 39, 49, 54, 55 and 59:**

3. Kanebo discloses a system, method, user interface, remotely accessible computer system configurable to allow a user to select a description of goods/services for at least one trade mark application said system comprising:

- a. means for presenting a predetermined list of goods/services to said user of said service system, said predetermined list being in accordance with an official classification of goods and services (Kanebo, Page 1, "To provide a trade mark registration application preparing device capable of automatically printing out work for a specified commodity or the work for, the specified commodity and a trade mark on a trade mark registration application.");
- b. said means for presenting said predetermined list being capable of, (Kanebo, Page 2, "1 Computer) (Examiner notes this meets all structural limitations claimed):
 - i. presenting a set of class headings for said list of goods/services (Kanebo, Page 5, [0011], "The contents storage 11 of application stores the extracted business which searches said relation enclosure 10 corresponding to appointed-goods-business by the receipt number generated by the input from the input unit 3 of said contents input means 6 of application, a classification, appointed goods, and the appointed goods inputted as other items when required, and corresponds."); and
 - ii. presenting said list of goods/services as a set of predetermined words describing individual said goods/services (Kanebo, Page 5, [0012],

"Next, actuation of the trademark registration application application listing device in this example is explained using the flow chart..."); and

iii. means for selecting individual said goods/services from said predetermined list, said means for selecting individual goods/services being capable of (Kanebo, Page 1, "The trade mark registration application preparing device consists of a specified commodity/work correspondence relation input means 5 for inputting correspondence between a specified commodity and work..."):

iv. selecting a class heading of goods/services, in which case a said selection corresponds to all goods/services stored in a predetermined list of goods/services corresponding to said heading (Kanebo, Page 1, "The trade mark registration application preparing device consists of a specified commodity/work correspondence relation input means 5 for inputting correspondence between a specified commodity and work..."); and

v. editing said predetermined list of goods/services by accepting modification of said set of predetermined words (Kanebo, Page 1, "...extracting its corresponding sort, specified commodity and work and outputting the extracted contents from a printer device 8 as an application.")

vi. Kanebo does not explicitly disclose wherein its system is an internet based system. However, eTEAS teaches a web-based system for requesting a trademark application from a remotely accessible computer

system (Examiner interprets this to be inherent within the concept of the internet, which allows remote access to a foreign computer). It would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated the internet into the device for preparing trade mark registration application in order to further facilitate the application process as described in the prior art of Kanebo on page 9. Further, this addition would not have been beyond one of ordinary skill in the art at the time of the invention since Kanebo already outputted the final application to a printer device as described on page 1 of Kanebo and doing could be performed readily and easily by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results.

4. With respect to **Claims 34-38, 40-46, 50-52, 56-57:**

5. Kanebo discloses all the above limitations, but does not explicitly disclose, wherein said means for presenting said goods/services comprises use of at least one drop down menu, the use of at least one scroll bar window, the use of at least one icon, the use of at least one box, a highlighting means, and an underlining means, whereby said user of said system selects said goods/services by using any of the aforementioned means to select said goods/services. However, eTEAS teaches each of these techniques which would have been obvious to one of ordinary skill in the art at the time of the invention to have incorporated into the device for preparing trade mark registration application of Kanebo, since so doing could be performed readily and easily

by any person of ordinary skill in the art, with neither undue experimentation, nor risk of unexpected results to display, present and list the class headings, classifications, and goods/services of Kanebo (Kanebo, Page 12, "While extracting the business which searches said relation storing means corresponding to appointed-goods-business by the appointed goods which were made to input a key item, a classification, and appointed goods from an input unit.")

6. With respect to **Claim 47**:

7. Kanebo discloses a method of presenting and selecting goods/services as claimed in claim 39, comprising the steps of: sorting said goods/services into the relevant classes following the presenting and selecting of said goods/services (Kanebo, Page 1, "extracting its corresponding sort, specified commodity and work and outputting the extracted contents from a printer device 8 as an application.")

8. With respect to **Claims 48, 53 and 58**:

9. Kanebo discloses the steps of presenting said goods/services as class headings using a first scrollbar window and presenting additional words of said goods/services using a second scrollbar window (Kanebo, Page 12, "While extracting the business which searches said relation storing means corresponding to appointed-goods-business by the appointed goods which were made to input a key item, a classification, and appointed goods from an input unit."). Kanebo does not explicitly disclose presenting of said goods/services in the official language of said country in which said trade mark application will be filed or specifying a country in which said trade mark application will be filed. eTEAS teaches wherein a selection must be made as the country which an

application is to be filed as well as the applicant's citizenship. It would have been obvious to one of ordinary skill in the art at the time of the invention to have used this selection made in eTEAS with the device for preparing trade mark registration application of Kanebo in order to allow the system to interact with any trade mark receiving office. Just as the system in Kanebo was designed in Japan, using Japanese language, the same system could have been modified with little effort in order to accommodate the language which is proper for the selection of citizenship made in eTEAS.

10. With respect to **Claims 60-62**:

11. Kanebo discloses extracting the corresponding sort and outputting the extracted work, but does not explicitly disclose wherein said means for selecting individual goods/services from said list is capable of: accepting deletion of individual words of said set of predetermined words; or accepting entry of additional text characters to describe words which specify said goods/services. However, it would have been obvious to one of ordinary skill in the art at the time of the invention to have added or accepted of any good/services presented or selected since a user would not want to submit an application with any discrepancies if it would be possible to catch them before submitting them.

Response to Arguments

Applicant's arguments with respect to claim 2/5/08 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MATTHEW S. MEYERS whose telephone number is (571)272-7943. The examiner can normally be reached on M-F 8:30-5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jan Mooneyham can be reached on (571) 272-6805. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Matthew S Meyers/
Examiner, Art Unit 3689
/Janice A. Mooneyham/

Supervisory Patent Examiner, Art Unit 3689